

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : **09/934841**
Applicant : Gilham
Filing date : August 23, 2001
Title : Security and Authentication of Postage Indicia
TC/A.U. : 3621
Examiner : **Sherr**
Docket No. : **5058**
Customer No. : 26936

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANTS' BRIEF (AMENDED) ON APPEAL TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

This is appellant's brief on appeal to the Board of Patent Appeals and Interferences, from the final rejection of claims 11 - 13 of the application identified above.

REAL PARTY IN INTEREST

The real party in interest is Neopost Limited, under an assignment from the invention recorded at reel 9331, frame 0243.

RELATED APPEALS AND INTERFERENCES

There is no related appeal or interference.

STATUS OF CLAIMS

Claims 1 - 10 have been canceled. Claims 11 - 13 are rejected.
Claims 11 - 13 are on appeal.

STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The method of claim 11 includes steps of: storing a secret key (Fig. 3, step 40); determining a period of time (page 12, line 10) in which postal indicia are to be printed on a plurality of mail items; storing a postage value relating to postage charges dispensed in said period of time; providing postage data including said postage value; generating a modified key (step 42) relating specifically to a mail item by utilizing said secret key and said postage data; generating an authentication code (step 41) by utilizing said modified key and said postage data; and printing said postage data and said authentication code as a postal indicium on said mail item (step 44).

The apparatus of claim 12 includes: clock means 29 (Fig. 1, page 12, line 11) operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items; a register 15,16 for storing a postage value relating to postage charges dispensed in said period of time; memory means 15,16 for storing a secret key; electronic control means 10 (page 4, line 24); and input means 12 (page 4, line 26) operable to input item data relating to a mail item to said electronic control means. The electronic control means is configured to generate (step 3, page 10, line 24) a modified key relating specifically to said mail item by utilizing said secret key and postage data (items 30 - 34, Fig. 2) including said item data and said postage value, and to generate an authentication code 35 (page 10, line 30) by utilizing said modified

key and said postage data.

Claim 13 additionally requires that the apparatus includes a further register for storing a value of credit (Fig. 5, page 11, line 29); and wherein said postage data includes said value of credit (page 11, lines 16 et seq.).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground is whether claims 11 to 13 would have been obvious from U.S. Patent 6249777 (Kara et al.) in view of U.S. Patent 5671146 (Windel et al.).

ARGUMENT

Claims 11 to 13 were finally rejected under 35 USC 103 as unpatentable over Kara et al. in view of Windel et al.

The claimed invention requires inter alia the features of generating a modified key for each mail item by utilizing a stored secret key and postage data which includes the postage value relating to postage charges dispensed in a determined period of time in which postal indicia are to be printed on a plurality of mail items, and utilizing this modified key to generate an authentication code.

As noted by the Examiner, Kara et al. makes no disclosure or suggestion of a method or apparatus which utilizes a modified key in the manner as required by the claimed invention.

In this connection, the Examiner cited Windel et al. (column 19, lines 1 to 5), and is alleging that the claimed invention is obvious from the teaching of Kara et al. in view of Windel et al.

Windel et al. does disclose the modification of a DES key, but this modification occurs only when the communication and accounting routines do not sequence within a predetermined time (column 18, line 65 to column 9, line 2), which allows for detection by the remote data center (column 19, lines 4 to 7) and prevents data communication (column 19, lines 19 to 21). Such modification of the DES key is entirely different to the key modification as required by the claimed invention.

Windel et al. makes no disclosure or suggestion whatsoever of the generation of a modified key for each mail item in the manner as required by the claimed invention, and certainly not to the utilization of that modified key for the purpose of generating an authentication code.

Furthermore, Windel et al. makes no disclosure or suggestion of the generation of a modified key which is based in part on postage value relating to postage charges dispensed in a determined period of time in which postal indicia are to be printed on a plurality of mail items.

The Examiner did not identify any teaching in Windel et al. to these features of the claimed invention, and furthermore did not put forward any argument that the skilled person would have been motivated further to modify the teaching of Kara et al.

Accordingly, it is submitted that the subject-matter of claims 11 to 13 is patentably distinguished over the disclosure of Kara et al when taken in view of Windel et al.

The Examiner commented (paragraphs 3 and 4 of the final rejection) that, on the basis that key modification is common in the field of postage meters, it would have been obvious to the skilled person to perform key modification at any stage and based on any postage information, and, in this regard, he made general reference to the prior art documents listed in paragraphs 14 to 18 of US Patent 4998204 (Sansone et al),

US Patent 5799086 (Sudia), US Patent 6424954 (Leon), US Patent 6587843 (Gelfer et al.) and US Patent 6889214 (Pagel et al.). Although this comment was not made in relation to the Section 103 rejection (paragraphs 6 to 11), we nevertheless wish to comment as follows.

The fact that key modification per se is known from the prior art manifestly does not render all inventions relating to key modification obvious, as apparently alleged by the Examiner, and certainly does render obvious the claimed invention.

Even with the knowledge of key modification, the skilled person would have had no incentive or motivation to modify the reference teachings to arrive at the claimed invention.

MPEP 2143.01 mandates that, for a Section 103 rejection, there must be some suggestion or motivation to modify reference teachings, and MPEP 2143.02 further mandates that, for a Section 103 rejection, there must be a reasonable expectation of success.

Also, for a Sec. 103 rejection to be proper, the suggestion of the claimed invention and the expectation of success must not be founded in Applicant's disclosure. *In re Dow*, 5 U.S.P.Q. 2d 1529,1531 (Fed. Cir. 1988).

For the above reasons, we submit that a *prima facie* case of obviousness of claims 11 to 13 has not been made out, and that the final rejections of those claims ought to be reversed.

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CLAIMS APPENDIX

11. A method of printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including the steps of:

storing a secret key;

determining a period of time in which postal indicia are to be printed on a plurality of mail items;

storing a postage value relating to postage charges dispensed in said period of time;

providing postage data including said postage value;

generating a modified key relating specifically to a mail item by utilizing said secret key and said postage data;

generating an authentication code by utilizing said modified key and said postage data; and

printing said postage data and said authentication code as a postal indicium on said mail item.

12. Postage meter apparatus for printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including:

clock means operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items;

a register for storing a postage value relating to postage charges dispensed in said period of time;

memory means for storing a secret key;

electronic control means; and

input means operable to input item data relating to a mail item to said electronic control means;

wherein said electronic control means is configured to generate a modified key relating specifically to said mail item by utilizing said secret key and postage data including said item data and said postage value, and generate an authentication code by utilizing said modified key and said postage data.

13. Postage meter apparatus as claimed in claim 12, including:
- a further register for storing a value of credit;
 - and wherein said postage data includes said value of credit.

EVIDENCE APPENDIX

(Not applicable.)

RELATED PROCEEDINGS APPENDIX

(Not applicable.)